

## **REMARKS**

### **1. Claim Amendments**

Claims 1, 5-10 and 14-21 are pending in the present application. Claims 1, 10, 17, 19, 20 and 21 are independent claims. Claims 2-4 and 11-13 have been cancelled, without prejudice. In the present submission, applicants have amended independent claims 1 and 10, without prejudice, to more distinctly recite the presently claimed invention. Particularly, claims 1 and 10 have been amended to incorporate the subject matter of previously dependent claims 2-4 and 11-13, respectively. Dependent claims 5, 6, 8, 9 and 14 are amended to provide for appropriate antecedent basis.

The Examiner has allowed claims 17 and 18. Claims 8, 9 and 16 are objected to as being dependent upon a rejected base claim. The Examiner has indicated that claims 8, 9 and 16 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Accordingly, new claims 19, 20 and 21 have been added consistent with the Examiner's instructions relative to the referenced objection as independent forms of claims 8, 9 and 16, respectively. Applicants respectfully submit that no new matter is introduced by way of the proposed claim amendments, and prompt entry thereof is respectfully requested.

More specifically, applicants have amended independent claim 1 to include the subject matter of previously dependent claims 2-4. Similarly, independent claim 10 has been amended to include the subject matter of previously dependent claims 11-13. Support for the proposed claim amendments is found throughout the specification, as originally filed, and such amendments merely incorporate previously presented claim recitations. As such, applicants respectfully submit that no new matter has been added. In addition, applicants submit that

consideration of amended claims 1 and 10 do not raise substantial new issues such that substantive consideration after Final Rejection would be improper or unwarranted.

## **2. 35 USC § 102(e) Rejections**

With reference to the outstanding claim rejections, claims 1-3, 7, 10-12, 14 and 15 stand rejected under 35 USC §102(e) as being anticipated by Setchell, US Patent No. 6,836,345 (the “Setchell ‘345 patent” or “Setchell”). Reconsideration is respectfully requested.

Claim 1 has been amended to include the subject matter of claims 2, 3 and 4. In view of the recitations added to independent claim 1, applicants respectfully submit that the Setchell ‘345 patent fails to recite all the process steps of claim 1, as amended. In particular, applicants note that the Setchell ‘345 patent fails to teach or suggest, *inter alia*, the recitations of previously set forth in dependent claim 4. The Examiner has acknowledged in paragraph 17 on page 5 that Setchell fails to teach the aspects of claim 4 stating, “[r]egarding claim 4....Setchell fails to disclose respectively assigning the different original types according to similarities in colorimetric properties to one of a number of original categories; setting one original type for each original category as master original; and providing a separate profile for each combination of master original and different scanning device, wherein the step of transforming is carried out with the profile that belongs to the actually used scanning device and to a master original which belongs to an original category to which the actual photographic original belongs.” (See e.g., Final Office Action, page 5, paragraph 17.)

According to the MPEP, “[t]o anticipate a claim, the reference must teach every element of the claim.” (See, e.g., MPEP § 2130.)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d

628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See e.g., MPEP §2130.)

With reference to the amendments and remarks set forth above, Setchell fails to anticipate the present application because it does not describe “each and every element” of the applicants’ claim. Therefore, the Section 102(e) rejection based on Setchell is obviated as to independent claim 1 and dependent claims 5-9, which depend therefrom. The outstanding obviousness rejection of dependent claim 4 (as previously presented) is addressed herein below.

Similarly to claim 1, independent claim 10 has been amended to include the subject matter of dependent claims 11, 12 and 13. As such, the Setchell ‘345 patent fails to recite all the process steps of Claim 10 and, at a minimum, the subject matter of previously dependent claim 13. The Examiner has acknowledged in paragraph 22 on page 7 that Setchell fails to teach the aspects of claim 13 stating, “[r]egarding claim 13 the steps of process claim 4 performs all of the means of apparatus claim 13. Thus, claim 13 is rejected for the same reasons discussed in rejection of claim 4.” (See e.g., Final Office Action, page 7, paragraph 22.) Accordingly, the remarks presented above regarding the distinguishing aspects as to amended claim 1 for purposes of the Section 102(e) rejection also apply to the distinguishing aspects of amended claim 10. Claims 14-16 are dependent upon claim 10 and thus overcome the Section 102(e) rejection for at least the foregoing reasons.

For at least the foregoing reasons, applicants respectfully submit that the Section 102(g) rejections of independent claims 1 and 10, as amended, are untenable. Similarly, applicants respectfully submit that the Section 102(e) rejections of all pending dependent claims, i.e., claims 5-9 and 14-16 (which depend directly or indirectly from the foregoing independent claims) should be withdrawn. Reconsideration and withdrawal of the Section 102(e) rejections based on Setchell are respectfully requested.

### **3. 35 USC § 103(a) Rejections**

With reference to the outstanding obviousness rejections, claims 4-6 and 13 were rejected under 35 USC §103(a) as being unpatentable over the Setchell '345 patent in view of Kiyokawa U.S. 2003/0112334 (the "Kiyokawa '334 application). Reconsideration is respectfully requested.

Claims 4 and 13 have been cancelled, without prejudice, and the subject matter thereof has been incorporated into independent claims 1 and 10, respectively. Thus, the remarks set forth herein below are associated with claims 1 and 10, as presently amended.

According to the Examiner, "Kiyokawa discloses respectively assigning the different original types according to similarities in colorimetric properties to one of a number of original categories (page 4, paragraph 0069); setting one original type for each original category as master original (page 4, paragraph 068); and providing a separate profile for each combination of master original and different scanning device, wherein the step of transforming is carried out with the profile that belongs to the actually used scanning device and to a master original which belongs to an original category to which the actual photographic original belongs (page 3, paragraph 056-0058).

"Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Setchell wherein Setchell's process steps are applied to assigning the different original types according to similarities in colorimetric properties to one of a number of original categories, setting one original type for each original category as master original and providing a separate profile for each combination of master original and different scanning device, wherein the transformation is carried out with the profile that belongs to the actually used scanning device and to a master original which belongs to an original category to

which the actual photographic original belongs. It would have been obvious to one of ordinary skill in the art at the time of the applicants' invention to modify Setchell by the teaching of Kiyokawa in order to provide a profile for each type of photograph based on the colorimetric values of the photograph." (Final Office Action, page 5-6, paragraph 19.)

Applicants respectfully traverse the rejection and respectfully submit that a combination of the Setchell patent and the Kiyokawa application does not lead to the presently claimed invention. Kiyokawa discloses image processing using a profile selection based on photographing conditions. These photographing conditions cannot be compared with and would certainly not motivate a person of ordinary skill in the art to employ "different original types," as described and claimed by applicants. According to the present application "different types of originals" are "different name brands and types of negatives or positives." (See e.g., applicants' specification, page 1, paragraph 3.) In contrast thereto, Kiyokawa's "photographing conditions" are described as "e.g., colours, white balances and exposure amounts of illuminating light during photographing." (See the Kiyokawa application, page 3, paragraph [0058].) Thus, Kiyokawa teaches a colorimetric reference that is completely different from that employed in applicants' claimed manufacturing processes and apparatus, wherein a profile is derived in part from "different types of originals."

Moreover, the solution for improving digital images suggested by Kiyokawa is completely different from the solution of the presently claimed invention. Monitoring photographing conditions in order to get a photograph of high quality, as described by Kiyokawa, differs completely from using different characteristics of determined profiles for getting high-quality digital images, wherein these profiles are determined in a conventional manner on the one hand and by direct scanning of non-developed originals on the other hand, as

described by the present application. Based on the fundamental difference in the design/operation of the Kiyokawa, applicants respectfully submit that it would not have been obvious to combine Kiyokawa with Setchell to arrive at the subject-matter claimed in independent claims 1 and 10, as amended.

Based on the foregoing distinctions and contrary teachings, applicants respectfully submit that the proposed combination of Setchell and Kiyokawa fails to teach or suggest the advantageous systems of independent claims 1 and 10, as amended. The proposed combination would not motivate a person skilled in the art to arrive at the subject matter of claims 1 and 10, respectively. The only teaching of such arrangement is found in applicants' disclosure/claims, and such disclosure cannot be used to pick and choose from prior art references to arrive at applicants' claimed invention. There must be a motivation or teaching in the prior art that would lead a person of ordinary skill in the art to combine/modify the prior art teachings in the manner proposed by the Examiner. See, e.g., *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) ("The examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination") There is no such suggestion/motivation in the Setchell and/or Kiyokawa patent, whether viewed alone or in combination.

For at least the foregoing reasons, applicants respectfully submit that independent claims 1 and 10, as amended, patentably distinguish over the Setchell patent in view of the Kiyokawa application. Moreover, applicants respectfully submit that all pending dependent claims, i.e., claims 5-9 and 14-18 (which depend directly or indirectly from the foregoing independent claims) are patentable for the reasons noted with respect to independent claims 1 and 10.

As noted previously, new independent claims 19-21 have previously been determined to recite patentable subject matter.

Applicants respectfully submit that all claims are now in condition for allowance. Reconsideration and withdrawal of the outstanding rejections based on the Setchell patent and/or the Kiyokawa application, alone or in combination, are respectfully requested. Applicants acknowledge that the outstanding rejections are "final;" however, applicants respectfully submit that the claim amendments and remarks set forth herein do no raise substantial new issues such that substantive consideration at this stage in prosecution should be withheld. Prompt issue of a Notice of Allowance is earnestly solicited.

If the Examiner believes that prosecution might be advance through a telephone conversation with applicants' attorney, the Examiner is invited to contact the undersigned at the noted number.

Respectfully submitted,



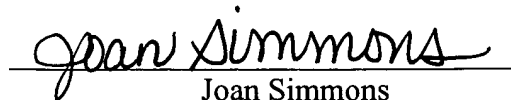
Mikhail Murshak  
Reg. No. 58,472  
Attorney for Applicants

Date: August 1, 2006

McCARTER & ENGLISH, LLP  
Financial Centre, Suite A304  
695 East Main Street  
Stamford, CT 06901  
(203) 399-5900

I hereby certify that this Amendment and Response is being deposited with the United States Postal Service as first class mail, postage prepaid, addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 1, 2006.

Dated: August 1, 2006



Joan Simmons